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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,234	11/19/2001	William S. Nevin	NEVIN-0001	8116
21261	7590	01/10/2006	EXAMINER	
ROBERT PLATT BELL REGISTERED PATENT ATTORNEY P.O. BOX 611467 POMPANO BEACH, FL 33061			COBANOGU, DILEK B	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/988,234

Applicant(s)

NEVIN ET AL.

Examiner

Dilek B. Cobanoglu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/19/2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-26 have been examined.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 14-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
4. Claim 14 is directed to generating a medical record from generated data. Such a generated record is merely a data structure *per se* and is, therefore, functional descriptive material that is not tangibly embodied. Therefore, claim 14 is directed to non-statutory subject matter. See MPEP 2106.
5. In addition, claims 15-25 are also directed to non-statutory subject matter as reciting nothing more than functional descriptive material that is not tangibly embodied.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

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351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-26 are rejected under 35 U.S.C. 102(e) as being unpatentable by Joao (U.S. Patent No. 6,283,761 B1).

As per claims 1-13, they are system claims, which repeat the same limitations of claims 14-26, the corresponding method claims, as a collection of elements as opposed to a series of process steps. Since the teachings of Joao discloses the underlying process steps that constitute the methods of claims 14-26, it is respectfully submitted that they provide the underlying structural elements that perform the steps as well. As such, the limitations of claims 1-13 are rejected for the same reasons given below for claims 14-26.

A. As per claim 14, Joao discloses a method of providing health care information comprising the steps of:

- i. defining a patient population (Joao; col. 14, lines 22-32);
- ii. generating patient interview data (Joao; col. 29, lines 28-35),
- iii. generating patient encounter information, combining patient interview data, and generating medical reports for each patient using patient interview data and patient encounter data (Joao; col. 16, lines 38-65).

B. As per claim 15, Joao discloses the method of providing health care information of claim 14, further comprising the steps of: assigning a health risk score to each patient based upon the generated medical report. (Joao; col. 17, lines 25-61).

C. As per claim 16, Joao discloses The method of providing health care information of claim 15, further comprising the steps of: analyzing patient medical reports and assigning a patient to a disease management track based upon patient medical reports. (Joao; col. 25, lines 39-53).

D. As per claim 17, Joao discloses the method of providing health care information of claim 16, wherein said disease management track comprises a medication recommendation program for an attending physician. (Joao; col. 17, lines 25-31).

E. As per claim 18, Joao discloses the method of providing health care information of claim 17, wherein said disease management track comprises a treatment recommendation program for an attending physician. (Joao; col. 7, lines 7-15).

F. As per claim 19, Joao discloses the method of providing health care information of claim 18, wherein said disease management track comprises an education program for a patient. (Joao; col. 18, lines 50-58).

G. As per claim 20, Joao discloses the method of providing health care information of claim 14, further comprising the step of: generating patient reports from the patient medical reports. (Joao; col. 20, lines 21-26).

H. As per claim 21, Joao discloses the method of providing health care information of claim 20, wherein said patient reports include medication non-compliance reports generated from patient medication data and prescription

claim data to indicate whether a patient has purchased a prescribed medication.
(Joao; col. 27, lines 2-8 and col. 16, lines 38-65).

I. As per claim 22, Joao discloses the method of providing health care information of claim 20, wherein the patient medical reports comprise patient temporary condition reports, indicating temporary medical conditions of a patient, and patient permanent condition reports, indicating permanent conditions of a patient. (Joao; col. 16, lines 38-65).

J. As per claim 23, Joao discloses the method of providing health care information of claim 20, wherein said patient medical reports include patient education reports, for educating a patient as to a medical condition. (Joao; col. 16, lines 38-65).

K. As per claim 24, Joao discloses the method of providing health care information of claim 20, wherein said patient medical reports include doctor reports summarizing patient medical history and medical condition. (Joao; col. 25, line 63 to col. 26, line 6).

L. As per claim 25, Joao discloses the method of providing health care information of claim 20, wherein said patient medical reports include medical provider reports summarizing patient medical claim history and medical claim status (Joao; col. 25, line 63 to col. 26, line 6).

M. As per claim 26, Joao discloses the method of providing health care information of claim 14, further comprising the steps of:

- i. downloading patient medical reports to a personal digital assistant (Joao; col. 14, lines 49-58 and col. 14, line 59 to col. 15, line 5);
- ii. uploading patient data entered by a physician into a personal digital assistant from the personal digital assistant (Joao; col. 5, lines 34-40 and col. 14, lines 49- 58); and
- iii. integrating such data into patient medical reports (Joao; col. 3, lines 34-45).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not used prior arts teach "Patient monitor and support system" 5,558,638 A, "Portable medical questionnaire presentation device" 5,572,421 A, "Medical history documentation system and method" 5,704,371 A, "System and method of generating prognosis and therapy reports for coronary health management" 5,724,580 A, "System and method for managing patient medical records" 5,772,585 A, "Systems, methods and computer program products for monitoring, diagnosing and treating medical conditions of remotely located patients" 6,024,699 A, "System and method for managing patient care" 2002/0169636, "Method and system for improving vascular systems in humans using biofeedback and network data communication" 2002/0183599, "Method, system and computer program product for internet-enabled, patient monitoring system" 2003/0036683, "Systems, methods and

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computer program products for monitoring, diagnosing and treating medical conditions of remotely located patients undergoing anticoagulation therapy" 6,589,169 B1.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dilek B. Cobanoglu whose telephone number is 571-272-8295. The examiner can normally be reached on 8-4:30.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DBC
Art Unit 3626
12/30/2005



C. LUKE GILTIGAN
PATENT EXAMINER